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Paper No.

SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT
(K-6-1, 1990)
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KENILWORTH NJ 07033-0530

COPY MAILED

APR 16 2007

OFFICE OF PETITIONS

In re Application of :
Hosted et al. : DECISION ON APPLICATION
Application No. 09/855,340 : FOR
Filed: May 15, 2001 : PATENT TERM ADJUSTMENT
Attorney Docket No. IN01164K :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT (PTA) UNDER 37 C.F.R. § 1.705," filed March 7, 2007. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred thirty-five (135) days to four hundred thirty-eight (438) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the notice of allowance is **four hundred thirty-eight (438)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On January 19, 2007, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 135 days. On March 7, 2007, applicants timely submitted the instant application for patent term adjustment¹. Applicants dispute the reduction of 130 days

¹ PALM records indicate that the Issue Payment was also filed on March 7, 2007.

associated with the filing on May 10, 2004 of a response to the restriction requirement mailed October 1, 2003. Applicants state that a reply was filed on November 3, 2003, and that the response was resubmitted on May 10, 2004 at the request of the examiner because he had not received the original response. Applicants point out that the USPTO PAIR system includes images of the response filed on November 3, 2003. In addition, applicants submit a copy of their return postcard receipt evidencing filing of the response on November 3, 2003. As the response was filed within the three-month period, the reduction for this delay pursuant to § 1.704(b) should be 0 days, not 130 days. Further, applicants assert that, given that the response was actually filed on November 3, 2003, a period of adjustment of 173 days (pursuant to §§ 1.702(a)(2) and 1.703(a)(2)) should be entered for the Office taking until August 23, 2004 to respond.

Applicants state that the application is not subject to a terminal disclaimer.

Applicants are correct. The application history shows that the reply is properly considered filed on November 3, 2003. Furthermore, applicants' characterization of the basis for and amounts of the corrections to the adjustments and reductions of patent term in this application given the filing of the reply on November 3, 2003 is correct.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is 438 days.

Receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The application is being forwarded to the Office of Patent Publication for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a long horizontal line extending from the end of the signature.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PAIR Screen

Day : Wednesday

PALM INTRANET

Date: 4/11/2007

Time: 16:19:30

PTA Calculations for Application: 09/855340

Application Filing Date:	05/15/2001	PTO Delay (PTO):	443
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	308
Post-Issue Petitions:	0	Total PTA (days):	438
PTO Delay Adjustment:	303		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
81	04/11/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	130		
80	04/11/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	173		
71	01/19/2007	MAIL NOTICE OF ALLOWANCE			
70	01/18/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
69	01/08/2007	NOTICE OF ALLOWABILITY			
68	10/04/2001	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
67	04/22/2002	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
66	04/22/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
65	10/04/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
64	12/24/2006	DATE FORWARDED TO EXAMINER			
63	12/01/2006	RESPONSE AFTER EX PARTE QUAYLE ACTION			
62	12/07/2006	ERROR(S) IN CRF CORRECTED BY STIC			
61	10/03/2006	MAIL EX PARTE QUAYLE ACTION (PTOL - 326)			
60	10/02/2006	EX PARTE QUAYLE ACTION			
59	07/18/2006	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
58	07/26/2006	DATE FORWARDED TO EXAMINER			
57	07/18/2006	RESPONSE AFTER NON-FINAL ACTION		12	53
56	07/18/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
55	07/06/2006	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
54	06/28/2006	EXAMINER INTERVIEW SUMMARY RECORD			

		(PTOL - 413)			
53	04/06/2006	MAIL NON-FINAL REJECTION			
52	04/03/2006	NON-FINAL REJECTION			
51	03/07/2006	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
50	03/10/2006	DATE FORWARDED TO EXAMINER			
49	03/07/2006	AMENDMENT AFTER FINAL REJECTION		20	46
48	03/07/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
47	11/30/2005	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
46	11/15/2005	MAIL FINAL REJECTION (PTOL - 326)			
45	11/14/2005	FINAL REJECTION			
44	10/12/2005	DATE FORWARDED TO EXAMINER			
43	09/29/2005	RESPONSE AFTER NON-FINAL ACTION		54	38
42	09/29/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
41	08/25/2005	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
40	08/15/2005	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
39	07/27/2005	CASE DOCKETED TO EXAMINER IN GAU			
38	05/06/2005	MAIL NON-FINAL REJECTION			
37	05/05/2005	NON-FINAL REJECTION			
36	03/11/2005	DATE FORWARDED TO EXAMINER			
35	02/23/2005	RESPONSE AFTER NON-FINAL ACTION		30	32
34	02/11/2005	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			
33	02/10/2005	DATE FORWARDED TO EXAMINER			
32.1	01/24/2005	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			
32	01/24/2005	RESPONSE AFTER NON-FINAL ACTION		62	28
31	01/24/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
30	02/10/2005	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
29	01/24/2005	WORKFLOW INCOMING AMENDMENT IFW			
28	08/23/2004	MAIL NON-FINAL REJECTION			
27	08/19/2004	NON-FINAL REJECTION			
26	06/08/2004	DATE FORWARDED TO EXAMINER			

25	05/10/2004	RESPONSE TO ELECTION / RESTRICTION FILED		130	23
24	05/10/2004	WORKFLOW INCOMING AMENDMENT IFW			
23	10/01/2003	MAIL RESTRICTION REQUIREMENT	443		-1
22	09/29/2003	REQUIREMENT FOR RESTRICTION / ELECTION			
21	06/19/2003	APPLICATION RETURN FROM OIPE			
20	08/22/2002	APPLICATION DISPATCHED FROM OIPE			
19	08/21/2002	APPLICATION IS NOW COMPLETE			
18	07/22/2002	A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN			
17	08/12/2002	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
16	06/18/2002	SEQUENCE ERRORS			
15	06/18/2002	PRE-EXAM OFFICE ACTION WITHDRAWN			
14	06/13/2002	APPLICATION RETURN TO OIPE			
13	05/21/2002	X-PRE-LEGAL COMPLETE NEW CASE			
12	01/16/2002	APPLICATION DISPATCHED FROM OIPE			
11	01/16/2002	APPLICATION IS NOW COMPLETE			
10	01/07/2002	APPLICATION MADE UNAVAILABLE FOR EXAMINATION			
9	12/18/2001	CASE DOCKETED TO EXAMINER IN GAU			
8	11/01/2001	APPLICATION DISPATCHED FROM OIPE			
7	11/01/2001	APPLICATION IS NOW COMPLETE			
6	07/19/2001	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
5	07/18/2001	CORRESPONDENCE ADDRESS CHANGE			
4	06/21/2001	ERROR(S) IN CRF CORRECTED BY STIC			
3	05/24/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
2	05/15/2001	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
1	05/15/2001	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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